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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,075	06/06/2001	Hiroshi Endo	9976-9US (OB0025US)	6219

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PHILADELPHIA, PA 19103

EXAMINER

ZHONG, CHAD

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,075

Applicant(s)

ENDO, HIROSHI

Examiner

Chad Zhong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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FINAL ACTION

1. This action is responsive to communications: Amendment, filed on 02/16/2005. This action has been made final.

Applicant's remarks filed 2/16/2005 have been considered but are found not persuasive in view at the new grounds at rejection necessitated by Applicant's amendment.

Note, applicant's arguments are geared towards the newly amended sections of claims, please refer to the body of office action for detailed analysis of the claims.

2. Claims 1-2, 4-14, 16-28 are presented for examination. In amendment B, filed on 02/16/2005:

claims 1, 13, 19 are amended

claims 3, 15 have been cancelled

claims 24-28 are new.

3. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.

Claim Rejections - 35 USC § 112, second paragraph

Claims 4, 19, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack antecedent basis:

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- i. said second address supplying - claim 4, does the applicant mean "said second address supplying device?".
 - ii. said first transmitting - claim 20
- b. The claim language in the following claims is not clearly understood:
 - i. as per claim 19, line 9, it is not clear as to what is meant by "said telephone number is judged to number correspond to", appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-14, 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda, US 6,690,480, in view of Jefferson, US 5,241,589.
6. As per claim 1, Maeda teaches an image communication apparatus (Fig 1, item 1, fax machine) for use in an image communication network system including a computer network being able to transmit and receive an image, based on a network address (Col. 6, lines 25-31), a first telephone network being able to transmit and receive said image based on a first telephone number (Fig 3, different telephone numbers correspond to different networks), a second telephone network being able to transmit and receive said image based on a second telephone number (Fig 3), a first address supplying device connected to said computer network adapted to store correspondence between said first telephone number and said network address corresponding to said first telephone number (Fig 3, wherein the correspondence between network address and telephone number is shown. The table in Fig 3 is available locally on a fax machine, however, its information contents are retrieved remotely from the receiving device, i.e.

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the internet fax capability is a functionality that is device dependent, the local device goes to the receiving device to retrieve such information, see for example, Col. 18, lines 15-37 for an illustrative teaching), and a second address supplying device connected to said computer network adapted to store correspondence between said second telephone number and said network address corresponding to said second telephone number (the first and second address supplying devices are remote receiving apparatuses, the addresses returned by these devices are stored in table on Fig 3.), comprising:

- an input section to input either of said first telephone number or said second telephone number provided to another image communication apparatus to which said image is to be transmitted, (Fig 1, item 13; Col. 9, lines 60-65, furthermore, a fax machine would inherently have key pad for number entry);

- a number transmitting section to transmit said input telephone number to address supplying devices (Col. 18, lines 15-37)

- an address receiving section to receive, in response to said telephone number fed from said telephone number transmitting section, a network address corresponding to said telephone number (Col. 18, lines 15-37, wherein the internet addresses are returned and are populated to the destination table, Fig 3); and

- an image transmitting section to transmit, based on said network address received by said address receiving section, said image to said another image communication apparatus through said computer network (Col. 18, lines 35-40).

Maeda does not explicitly teach:

- the first telephone number corresponding to said first telephone network and the second telephone number corresponding to said second telephone network;

- a judging section to judge whether said telephone number input through said input section corresponds to said first telephone network or said second telephone network

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In a similar system, Jefferson teaches fax image transmission through fax card (Col. 3, lines 5-10; Col. 5, lines 45-48), users would input the telephone numbers and a judgment/determination (Col. 5, lines 25-30) is made in Jefferson in order to identify which corresponding network the telephone number belongs to, i.e. whether it is Internal, Outside Local, Long Distance or International (see the example show in Col. 5, line 45 – Col. 6, lines 30). Note, Internal, Outside Local, Long Distance or International corresponds to at least two different telephone networks. The above steps of judging is done in order to route the call/image transmission to the appropriate destination in accordance with the network that the number is associated with.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine teachings of Maeda and Jefferson because judging telephone numbers as used by Jefferson would lead to routing the first telephone number and the second telephone number of Maeda in accordance with first telephone network or second telephone network, and would result in enhancing of the communication speed in Maeda's system.

7. As per claim 2, Maeda does not explicitly teach the image communication apparatus according to claim 1, wherein said judging section judges whether said input telephone number has been registered

In a similar system, Jefferson teaches fax image transmission through fax card (Col. 3, lines 5-10; Col. 5, lines 45-48), users would input the telephone numbers and a judgment/determination (Col. 5, lines 25-30) is made in Jefferson in order to identify which corresponding network the telephone number belongs to, i.e. whether it is Internal, Outside Local, Long Distance or International (see the example show in Col. 5, line 45 – Col. 6, lines 30). Note, Internal, Outside Local, Long Distance or International corresponds to at least two different telephone networks. The numbers would have to be registered in advance for this judging to take place in Jefferson's System.

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine teachings of Maeda and Jefferson because judging telephone numbers as used by Jefferson would lead to routing the first telephone number and the second telephone number of Maeda in accordance with first telephone network or second telephone network, and would result in enhancing of the communication speed in Maeda's system.

8. As per claim 4, Maeda teaches the image communication system according to claim 1, wherein said image communication apparatus is provided with said first address supplying device and said second address supplying as function sections of said image communication apparatus (Fig 3, it should be noted that Fig 3's fields are populated as per query to remote receivers. In one embodiment the receivers are remote fax machines, the local fax machine can fill table in Fig 3 in accordance with remote device capabilities. This is taught for example, in Col. 18, lines 15-35).

9. As per claim 5, Maeda teaches the image communication device according to claim 1, further comprising a second image transmitting section to transmit images to said another image communication apparatus through either of said telephone network for use in said first telephone number or said telephone network for use in second telephone number (Col. 18, lines 35-40).

10. As per claim 6, Maeda teaches the image communication device according to claim 5, further comprising a signal receiving section to receive, when said second image transmitting section transmits a first image, using either of said first telephone number or said second telephone number, to said another image communication apparatus through either of said telephone network for use in said first telephone number or said telephone network for use in second telephone number, a signal containing (the signals are signals returned from the receiver side) a computer address (Col. 18, lines 22-30, the internet address is transmitted by the remote

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computer and stored locally at the local computer if the remote device can support internet fax) provided to said image communication apparatus on a receiver side which is returned, in response to said transmitting of said image, from said another image communication apparatus and wherein said first image transmitting section is adapted to transmit a second image contained in said signal received by said signal receiving section, based on said computer address of said another image communication apparatus, to said another image communication apparatus through said computer network (Col. 18, lines 15-40).

11. As per claim 7, Maeda teaches the image communication apparatus according to claim 6, further comprising a storage section to store correspondence between said telephone number used by said image transmitting section when said first image is transmitted and received through either of said telephone network for use in said first telephone number or said telephone network for use in said second telephone number and said network address of said another image communication apparatus received by said signal receiving section when said first image is received (Fig 3; Col. 6, lines 20-30).

12. As per claim 8, Maeda teaches the image communication apparatus according to claim 5, wherein said second image transmitting section, when said first image transmitting section fails to transmit said image based on said computer address through said computer network, transmits said image using either of said first telephone number or said second telephone number through either of said telephone network for use in said first telephone number or said telephone network for use in said second telephone number (Fig 4; Col. 12, lines 30-40, lines 50-63, wherein the user designate an internet fax mode, however the receiver does not support internet fax mode, hence the fax will be sent via regular telephone number).

13. As per claim 9, Maeda teaches the image communication apparatus according to claim 5, further comprising an operation section to designate to which priority is given, transmission by

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said first image transmitting section through said computer network or transmission by said second image transmitting section through said telephone network (Col. 12, lines 30-40, lines 50-60; see also Fig 1, item 3 and 4, wherein the fax can be transmitted either via the internet or regular telephone network).

14. As per claim 10, Maeda teaches the image communication apparatus according to claim 9, wherein said operation section, when said first image transmitting section fails to transmit said image through said computer network, designates whether said image is to be transmitted by said second image transmitting section through said telephone network (Col. 12, lines 50-62; wherein the user designate an internet fax mode, however the receiver does not support internet fax mode, hence the fax will be sent via regular telephone number).

15. As per claim 11, Maeda teaches the image communication apparatus according to claim 1, wherein said first telephone network is an inside telephone network that is able to transmit and receive said image based on said first telephone number being said inside telephone number and said second telephone network is an outside telephone network that is able to transmit and receive said image based on said second telephone number being said outside telephone number and wherein said computer network is either of an intranet or the Internet that is able to transmit and receive said image based on said network address being an IP (Internet Protocol) address (Fig 2-4; Col. 1, lines 35-41, wherein the Maeda is able to transmit internet faxes on the external network after receiving the internet address).

16. As per claim 12, Maeda teaches the image communication apparatus according to claim 1, wherein said number transmitting section transmits said input number through said computer network and said address receiving section receives said network address through said computer network (Fig. 3; Col. 1, lines 35-45).

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17. As per claim 13, the claim is rejected for the same reasons as rejection to claim 1 above.

18. As per claim 14, the claim is rejected for the same reasons as rejection to claim 2 above.

19. As per claim 16, Maeda teaches the image communication system according to claim 13, wherein said image communication system is provided with, as its function section, either of said first address supplying device or said second address supplying device (Col. 6, lines 22-40).

20. As per claim 17, Maeda teaches the image communication system according to claim 16, wherein said image communication apparatus further includes an operation section to designate either of said image communication apparatus having either of said first address supplying device or said second address supplying device as a device from which said network address is acquired (Col. 6, lines 22-40, it should be noted that address supplying devices are receiving units so there are plurality of receiving devices resulting in at least two address supplying devices).

21. As per claim 18, the claim is rejected for the same reasons as rejection to claim 12 above.

22. As per claim 19, the claim is rejected for the same reasons as rejection to combination of claims 1 above.

23. As per claim 20, Maeda teaches the image communication method according to claim 19, further comprising:

second transmitting said image to said another image communication apparatus, based on said first telephone number, through a first telephone network and a second telephone network;
and

selectively performing either of said first transmitting and said second transmitting (Col. 2, lines 30-42).

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24. As per claim 21, the claim is rejected for the same reasons as rejection to claims 9 above.

25. As per claim 22, the claim is rejected for the same reasons as rejection to claims 10 above.

26. As per claim 23, Maeda teaches the image communication method according to claim 19, further comprising:

receiving a signal which is to be received from said another image communication apparatus through either of said first telephone network or said second telephone network and which contains a computer address of said another image communication apparatus;

extracting a computer address of said another image communication apparatus from said received signal; and

wherein said first transmitting is used to transmit said image, based on said extracted computer address, through said computer network to said another image communication apparatus (Col. 18, lines 15-40).

27. As per claim 24, the claims is rejected for the same reasons as rejection to claim 1 above.

28. As per claim 25, Maeda teaches the image communication system according to claim 24, wherein the first image communication apparatus and the second image communication apparatus each respond to an outside telephone number used for outside communication, and a network address (see for example, table 3, where the outside phone numbers correspond to a network address).

However, Maeda does not explicitly teach the communication apparatuses each correspond to an inside telephone number used for inside communication.

In a similar system, Jefferson teaches fax image transmission through fax card (Col. 3, lines 5-10;

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Col. 5, lines 45-48), users would input the telephone numbers and a judgment/determination (Col. 5, lines 25-30) is made in Jefferson in order to identify which corresponding network the telephone number belongs to, i.e. whether it is Internal or inside communication, Outside Local, Long Distance or International (see the example show in Col. 5, line 45 – Col. 6, lines 30). Note, Internal, Outside Local, Long Distance or International corresponds to at least two different telephone networks.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine teachings of Maeda and Jefferson because judging telephone numbers as used by Jefferson would lead to routing the first telephone number and the second telephone number of Maeda in accordance with first telephone network (internal) or second telephone network (external), and would result in enhancing of the communication speed in Maeda's system.

29. As per claims 26-27, the claims are rejected for the same reasons as rejection to claim 1 above.

30. As per claims 28, the claim is rejected for the same reasons as rejection to claims 1 and 6 above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reined of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "IMAGE COMMUNICATION APPARATUS IMAGE COMMUNICATION SYSTEM AND IMAGE COMMUNICATION METHOD".

- i. US 2003/0039237 Forsolw
- ii. US 6584098 Dutnall
- iii. US 6215790 Voit et al.
- iv. US 6587684 Hsu et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BURGESS, GLENTON B can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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May 24, 2005